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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/779,421	02/13/2004	Robert H. Wollenberg	T-6320 (538-66)	9070
<div>7590 01/30/2007 Michael E. Carmen, Esq. M. CARMEN & ASSOCIATES, PLLC Suite 400 170 Old Country Road Mineola, NY 11501</div>			<div>EXAMINER GROSS, CHRISTOPHER M</div> <div>ART UNIT PAPER NUMBER 1639</div>	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		01/30/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/779,421	WOLLENBERG, ROBERT H.	
	Examiner	Art Unit	
	Christopher M. Gross	1639	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) 22-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21, 33 and 34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)

Paper No(s)/Mail Date 2/16/06; 3/18/04

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Responsive to communications entered 10/30/2006. Examiner on the instant case has changed (see contact information below). Claims 1-34 are pending. Claims 22-32 are withdrawn. Claims 1-21,33-34 are examined herein.

Election/Restrictions

Applicant's election with traverse of group I (claims 1-21) and the species: "motor oil plus detergent" as the lubricating oil composition library from claims 1,33 and 34 and an "elastomer seal" for the elastomer of claims 4 and 5 in the reply filed on 10/30/2006 is acknowledged. The traversal is on the ground(s) that a prior art search for the method of screening lubricating oil compositions (group I) would provide art related to the system related to screening lubricating oil compositions of group II.

This is not found persuasive because the prior art search for the method that is group I is not coextensive with the search for the system that is group II. Prior art searches of the method of invention I and the system of invention II are not coextensive: patent and non-patent literature databases would need to be queried for separate keywords and an in-depth analysis performed addressing the automation afforded by invention II, comprising movable carriages, bar code readers, etc. which would not be necessary for a thorough search and examination of the method steps concerning invention I

The requirement is still deemed proper and is therefore made FINAL.
Claims 22-32 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim.

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Applicant timely traversed the restriction (election) requirement in the reply filed on 10/30/2006.

Priority

This application has a filing date of 2/13/2004. Applicant makes no claim for the benefit of any prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3,5-9,21,33-34 are rejected under 35 U.S.C. 102(b) as being anticipated by **Francisco et al** (US Patent 5,308,522)

The claimed invention is drawn to a high throughput method for screening lubricating oil composition samples for compatibility with elastomers, under program control, comprising the steps of:

(a) providing a plurality of different lubricating oil composition samples, each sample comprising

(i) a major amount of at least one base oil of lubricating viscosity and

(ii) a minor amount of at least one lubricating oil additive;

- (b) providing at least one elastomer;
- (c) measuring the elastomer compatibility of each sample to provide elastomer compatibility data for each sample; and,
- (d) outputting the results of step (c).

Francisco et al teach throughout the document and especially example 3, stress activated activators (I and II) for lubricant compositions which are tested on an elastomer.

The testing of the stress activated activators per Francisco et al includes a base oil and a small amount of different oil additives and therein reads on claim 1 (a). The elastomer tested is taken as the elastomer of claim 1 (b). Data concerning the compatibility of the elastomer is "output" and presented as table 2 by Francisco et al thus reading on claim 1(d).

Also shown in table 2, Francisco et al teach the elastomer compatibility with the oil and additive mixture is discerned by measuring elastomer tensile strength, as compared the tensile strength prior to immersion in the oil mixture, therein reading on claim 1(c) as well as 8 and 9.

Francisco et al teach in column 2, synthetic oils per claim 2. Francisco et al teach detergents (elected species) in column 3, line 43 as set forth in claim 3. Francisco et al teach in column 6, line 39 the elastomer is a seal (elected species) as set forth in claims 4 and 5.

Francisco et al teach in column 6, line 59 the elastomer is immersed in the test solution for a predetermined time of 96 hours at and predetermined temperature of 121 degrees C, reading on claim 6 and in the range of claim 7.

Francisco et al teach in column 6, line 61, the oil mixture is diluted with another oil, reading on claim 21.

Since a library can have as few as two members, the composition of two different additives (I and II) per Francisco et al read on claim 33. The aforementioned data table of Francisco et al is taken as meeting the limitations set forth in claim 34.

Claims 1,2,4-5,8,10-12 are rejected under 35 U.S.C. 102(b) as being anticipated by **Migdal et al** (US Patent 5,062,980)

Migdal et al teach throughout the document and especially columns 13 and 14, polysuccinimide compositions as dispersants for lubricating oils.

Migdal et al teach in table II the compatibility of Viton engine elastomer seals with said dispersants by both tensile strength and elongation, which reads on claims 1(a)-(c) as well as claims 8 and 10. Data concerning the compatibility of the elastomer is "output" and presented as table 2 by Migdal et al thus reading on claims 1(d).

Absent evidence to the contrary, the oil used by Migdal et al is either synthetic or natural, and is taken to meeting the limitation of claim 2. The Viton engine elastomer seals of Migdal meet the limitation of claim 5 and is taken as representing a synthetic rubber, per claim 4.

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Migdal et al teach in column 13, line 59, 20 ml samples were used, meeting the limitations of claims 11 and 12.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3,5-9,21, 33-34 and 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Francisco et al** (US Patent 5,308,522) in view of **Chaffee et al** (US Patent 4,774,281).

Francisco et al is relied on as above.

Francisoco et al do not teach thermal conditioning of the elastomer at a temperature at about 100-200 degrees C for about 20 hours to about 60 hours, prior to immersing the elastomer in the oil/additive sample, such as set forth in claims 15 and 16.

Chaffee et al teach, throughout the document and especially in column 2, line 47 thermal conditioning of a rubber stock at 177 degrees C for 22 hours.

It would have been *prima facie* obvious for one of ordinary skill in the art, at the time the claimed invention was made to apply the thermal conditioning of Chaffee et al. toward the elastomer testing protocol of Francisco et al.

One of ordinary skill in the art would have been motivated to use the thermal conditioning of Chaffee et al in the elastomer testing protocol of Francisco et al because it would have provided an improved compression set, as noted by Chaffee et al in column 1, line 44.

One of ordinary skill in the art would have had a reasonable expectation of success in combining the thermal conditioning of Chaffee et al with the elastomer testing protocol of Francisco et al because Chaffee et al had applied thermal conditioning to silicone rubber. Therefore it would not have been unreasonable to apply thermal conditioning to the method of Francisco et al because silicone rubber is well within the scope of synthetic rubber (elastomer seals).

Claims 1-3,5-9,21, 33-34 and 11-14,17-20 rejected under 35 U.S.C. 103(a) as being unpatentable over **Francisco et al** (US Patent 5,308,522) in view of **Kolosov et al** (US Patent Application 2004/0123650 – IDS entry 2/126/2006)

Francisco et al is relied on as above.

Francisco et al do not teach sample sizes no more than 10 ml (claim 14), the use of a robotic assembly (claim 17), control by a computer (claim 18), storing data (claim 19) or using the data of claim 1(c) for further calculations (claim 20).

Kolosov et al teach, the document and especially figure 1 the use of a robot which is controlled by a computer to screen and analyze a library of material samples.

Kolosov et al teach in and paragraph 0021 sample sizes as small a 1 ml, which is in the range of claims 11-14.

It would have been *prima facie* obvious for one of ordinary skill in the art, at the time the claimed invention was made to use the computer controlled robot of Kolosov et al with the elastomer testing protocol of Francisco et al.

One of ordinary skill in the art would have been motivated to use the computer controlled robot of Kolosov et al with the elastomer testing protocol of Francisco et al because of the need to reduce time in analyzing samples and it would be especially attractive to rapidly test a plurality of samples on a common substrate, as noted by Kolosov et al in paragraph 0005.

One of ordinary skill in the art would have had a reasonable expectation of success in combining the computer controlled robot of Kolosov et al with the elastomer testing protocol of Francisco et al because Kolosov et al has applied the computer controlled robot toward rheological studies (e.g. viscosity or elasticity). Therefore it would not have been unreasonable to apply the computer controlled robot as part of the method of Francisco et al because tensile strength is directly related to elasticity.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct

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from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-3 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4 of U.S. Patent No. 7,137,289 in view of Francisco et al (US Patent 5,308,522) and further view of Bailey et al (US Patent 3,108,397)

Instant claim 1 is drawn to a method of screening lubricating oil compositions for compatibility with elastomers comprising the steps outlined above.

Reference claim 1 is drawn to a method of screening lubricating oil compositions for dispersancy performance using the same steps as the instant invention, plus adding sludge.

The limitations of instant claims 2-3 are reflected in claims 2-4 of US Patent 7,137,289.

The instant claimed invention differs from application 11/528747 in measuring dispersancy and the addition of sludge and elastomers.

Francisco et al teach throughout the document and especially example 3, stress activated activators (I and II) for lubricant compositions which are tested on an elastomer.

Bailey et al teach, throughout the document and especially paragraphs 2 and 3 of column 1, measuring lubricating oil dispersancy in an effort to prevent sludge formation.

One would have been motivated to measure dispersancy with the instant method because it would have promoted engine cleanliness, as noted by Bailey et al in column 1, line 40.

Claims 1-3 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4 of copending Application No. 11/528747 in view of Bailey et al (US Patent 3,108,397).

Instant claim 1 is drawn to a method of screening lubricating oil compositions for compatibility with elastomers comprising the steps outlined above.

Reference claim 1 is drawn to a method of screening lubricating oil compositions for dispersancy performance using the same steps as the instant invention, including adding an amount of base-oil insoluble material. An elastomer is considered a base-oil insoluble material.

The limitations of instant claims 2-3 are reflected in claims 2-4 of application 11/528747.

The instant claimed invention differs from application 11/528747 in measuring dispersancy.

Bailey et al teach, throughout the document and especially paragraphs 2 and 3 of column 1, measuring lubricating oil dispersancy.

One would have been motivated to measure dispersancy with the instant method because it would have promoted engine cleanliness, as noted by Bailey et al in column 1, line 40.

This is a provisional obviousness-type double patenting rejection.

Claim 1 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 11/699510 in view of Francisco et al (US Patent 5,308,522).

Instant claim 1 is drawn to a method of screening lubricating oil compositions for compatibility with elastomers comprising the steps outlined above.

Reference claim 1 is drawn to a method of screening lubricating oil compositions using the same steps, as the instant invention except for (d) "outputting the results"

Francisco et al teach throughout the document and especially example 3, stress activated activators (I and II) for lubricant compositions which are tested on an elastomer.

Data concerning the compatibility of the elastomer is "output" and presented as table 2 by Francisco et al thus reading on claim 1(d).

One would have been motivated to output the data of the instant method into table because it would allow one to compare the performance of the stress activated activators, as demonstrated by Francisco et al.

This is a provisional obviousness-type double patenting rejection.

Claims 1 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of each of copending Application Nos. 11/605127, 10/699508, 10/699507, 10/779422 in view of Francisco et al (US Patent 5,308,522) and Guninther et al (US Patent Application 2004/0074452).

Instant claim 1 is drawn to a method of screening lubricating oil compositions for compatibility with elastomers comprising the steps outlined above.

Reference claim 1 of application 11/605127 is drawn to a method of screening lubricating oil compositions to measure wear stability using the same steps as the instant invention.

Reference claim 1 of application 10/699508 is drawn to a method of screening lubricating oil compositions to measure oxidation stability using the same steps as the instant invention.

Reference claim 1 of application 10/699507 is drawn to a method of screening lubricating oil compositions measuring storage stability using the same steps as the instant invention.

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Reference claim 1 of application 10/779422 is drawn to a method of screening lubricating oil compositions measuring deposit formation using the same steps as the instant invention.

The instant claimed invention differs from application 11/528747 in measuring elastomer compatibility rather than any of wear stability, oxidation stability, storage stability or deposit formation.

Francisco et al teach throughout the document and especially example 3, stress activated activators (I and II) for lubricant compositions, which are tested on an elastomer.

Guninther et al teach, throughout the document and especially paragraph 0013, performance fuels, which minimize valve deposits, protect against wear and oxidation and increase storage stability.

One would have been motivated to optimize parameters such as deposit formation, wear stability, storage stability and minimizing oxidation because each of which is a desirable property for use in an internal combustion engine, according to Guninther et al in paragraph 0013.

This is a provisional obviousness-type double patenting rejection.

Conclusion

Claims 1-21,33-34 are not allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher M. Gross whose telephone number is (571)272-4446. The examiner can normally be reached on M-F 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. Douglas Schultz can be reached on 571 272-0763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Christopher M Gross
Examiner
Art Unit 1639

cg


MARK L. SHIBUYA
PRIMARY EXAMINER